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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,833	08/03/2001	Yoshikatsu Ueda	H-988	7520

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EXAMINER	
CLOW, LORI A	

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,833	UEDA ET AL.	
	Examiner	Art Unit	
	Lori A. Clow, Ph.D.	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, drawn to a chip which comprises probes selectively disposed thereon for acquiring genetic information necessary for prescribing a genomic drug, classified in class 435, subclass 174.

II. Claims 5-8, 12, and 16, drawn to a genomic drug prescription support system, storage medium, and memory which comprises pattern input, classified in class 702, subclass 20.

III. Claims 9 and 13, drawn to a genomic drug prescription support system and storage medium which comprises genetic information input, classified in class 702, subclass 20.

IV. Claims 10 and 14, drawn to a chip information offering system and storage medium which comprises sales information, classified in class 705, subclass 2.

V. Claim 11, drawn to a chip supply system, classified in class 705, subclass 28.

VI. Claim 15, drawn to a chip comprising probes wherein probes are nucleic acid sequences that hybridize related nucleic acid sequences to determine the action of a genomic drug, classified in class 435, subclass 287.2.

VII. Claims 17-18, drawn to a method of making a chip for acquiring genetic information, classified in class 435, subclass 6.

VIII. Claims 19-21, drawn to a method, computer program, and storage device for providing prescription information of a genomic drug, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions. The invention of Group I is a chip comprising of probes for acquiring genetic information. The invention of Group II is a genomic prescription support system. These are two entirely distinct products with different functions.

The inventions of Group I and III are unrelated. The invention of Group I is a chip comprising of probes for acquiring genetic information. The invention of Group III is a genomic prescription support system. These are two entirely distinct products with different functions.

The inventions of Group I and IV are unrelated. The chip of Group I contains probes for genetic information while the chip system of Group IV contains sales information concerning the number of chips sold. These are two distinct inventions with different functions.

The inventions of Group I and V are unrelated. The invention of Group I is a chip comprising probes for acquiring genetic information necessary for prescribing a genomic drug. This is different for the chip supply system of Group V which is used to monitor chip stock supplies. These are two distinct inventions with different functions.

The inventions of Group I and Group VI are unrelated. The chip of Group I for acquiring genetic information necessary for prescribing a genomic drug is different from the chip of Group VI which contains specific probes, namely nucleic acids. The two inventions are distinct and have different functions.

Inventions of Group I and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the chip of Group I does not have to be made by the process of Group VII. The chip could be made utilizing a different technique, such as taking only certain sequences from a human and disposing them on a chip.

The inventions of Group I and Group VIII are unrelated. The chip of Group I has nothing to do with the method for providing prescription information presented in Group VIII. These are two distinct inventions.

The inventions of Group II and Group III are unrelated. The genomic drug prescription system of Group II consists of pattern input means whereas the genomic prescription system of Group III consists of inputting any genetic information, not necessarily in a pattern.

The inventions of Group II and IV are unrelated. The genomic drug prescription system of Group II and the chip information offering system of Group IV are different in that the prescription system of II is for nucleotide sequence input and the information system of Group IV is for sales information.

The inventions of Group II and V are unrelated. The prescription system of Group II is different from the chip supply system of Group V in that Group V is a system of monitoring stock supplies and the system of Group II is for determining genetic information.

The inventions of Group II and Group VI are unrelated. The genomic drug prescription system of Group II is different for the chip of Group VI in that the chip of Group VI contains

nucleotide probes which hybridize with related probes and the system of Group II contains hybridization pattern information.

The inventions of Group II and Group VII are unrelated. The method of making a chip in Group VII is a distinct invention from the prescription support system of Group II. The chip contains probes from a genome and the system contains pattern information gathered from chip readings.

The inventions of Group II and Group VIII are unrelated. The method of providing prescription information in Group VIII is different from the system of Group II in that the method contains polymorphic information which is not a limitation of the system.

The inventions of Group III and IV are unrelated. The genomic drug prescription system of Group III and the chip information offering system of Group IV are different in that the prescription system of III is for genetic information input and the information system of Group IV is for sales information.

The inventions of Group III and V are unrelated. The prescription system of Group III is different from the chip supply system of Group V in that Group V is a system of monitoring stock supplies and the system of Group III is for determining genetic information.

The inventions of Group III and VI are unrelated. The genomic drug prescription system of Group III is different for the chip of Group VI in that the chip of Group VI contains nucleotide probes which hybridize with related probes and the system of Group III contains any genetic information.

The inventions of Group III and VII are unrelated. The method of making a chip in Group VII is a distinct invention from the prescription support system of Group III. The chip

contains probes from a genome and the system contains information gathered from chip readings.

The inventions of Group III and VIII are unrelated. The method of providing prescription information in Group VIII is different from the system of Group III in that the method contains polymorphic information which is not a limitation of the system.

The inventions of Group IV and Group V are unrelated. The chip system of Group IV is for sales information while the chip system of Group V is to monitor stock supplies.

The inventions of Group IV and VI are unrelated. The chip information system of Group IV for sales monitoring is distinct from a chip which contains nucleic acid sequences for comparison to other nucleic acid sequences to determine action of a drug.

The inventions of Group IV and VII are unrelated. The method for making a chip of Group VII is not the method used to make the system of Group IV, which is a system for chip sales information.

The inventions of Group IV and VIII are unrelated. The method of providing prescription information in Group VIII is different from a system that provides sales information.

The inventions of Group V and VI are unrelated. The chip information system of Group V for stock monitoring is distinct from a chip which contains nucleic acid sequences for comparison to other nucleic acid sequences to determine action of a drug.

The inventions of Group V and VII are unrelated. The method for making a chip of Group VII is not the method used to make the system of Group V, which is a system for chip stock information.

The inventions of Group V and VIII are unrelated. The method of providing prescription information in Group VIII is different from a system that provides stock information.

Inventions of Group VI and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of Group VII can be used to make chips other than the chip of Group VI. For instance, the method could be used to make a chip that comprises probes for monitoring overexpressed genes for cancer detection.

The inventions of Group VI and VIII are unrelated in that the method for providing prescription information does not require a chip that contains probes with nucleic acid sequence information only. It requires polymorphic information, as well.

The inventions of Group VII and VIII are unrelated. The method for making a chip in Group VII is distinct from the method of providing prescription information. The steps to reach and outcome and the outcome of the two inventions are completely different.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143)

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.148(b) and by the fee required under 37 CFR 1.17(h).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D. whose telephone number is 703-306-5439. The examiner can normally be reached on Monday thru Friday, 10:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Lori A. Clow
AU 1631

MARJORIE MORAN
PATENT EXAMINER